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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/382,372	08/24/1999	JEFFRY JOVAN PHILYAW	PHLY-24738	5133

25883 7590 02/27/2002

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EXAMINER

KANG, PAUL H

ART UNIT	PAPER NUMBER
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2152

DATE MAILED: 02/27/2002

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/382,372

Applicant(s)

PHILYAW

Examiner

Paul H Kang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4 and 5. 6) ☐ Other:

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1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1 and 2 are provisionally rejected under the judicially created doctrine of double patenting over pending claims of co-pending Application No. 09/625,445. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the context of the claimed invention is the same as the context of the co-pending application.

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3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hudetz et al., US Pat. No. 5,978,773, in view of Gatto et al., US Pat. No. 5,905,521.

4. As to claim 1, Hudetz teaches the invention substantially as claimed. Hudetz teaches receiving a signal comprising a unique coded information;

connecting the user's computer to an advertiser's location in response to extracting the unique coded information from the audio signal, and the advertiser's location being correlated to the unique coded information (Hudetz, abstract and col. 3, line 17 – col. 4, line 30);

the step of connecting causing profile information of the user to be sent to the advertiser's location over the network, receiving the profile at the advertiser's location (Hudetz, col. 3, line 17 – col. 4, line 30 and col. 8, line 11 – col. 9, line 21); and

generating information to forward to the user based upon the user's profile forwarded thereto and forwarding this information to the connected user (Hudetz, col. 3, line 17 – col. 4, line 30 and col. 8, line 11 – col. 9, line 21).

However, Hudetz does not explicitly teach the received signal as a broadcast signal generated by an advertiser. In the same field of endeavor, Gatto teaches an advertising system using a broadcast message over a television network (Gatto, col. 1, line 34 – col. 3, line 11 and

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col. 3, line 24 – col. 4, line 26). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated the broadcast message signal, as taught by Gatto, into the advertising system of Hudetz for the purpose of maximizing advertisement reach and system efficiency.

5. As to claim 2, Hudetz-Gatto teaches extracting the information from the unique coded information as a unique code;

transmitting the extracted unique code to an intermediate location on the network (Hudetz, col. 8, line 11 – col. 9, line 21);

transmitting to the intermediate location from the user's computer a unique user ID associated with the user and which was stored at the user's computer (Hudetz, abstract and col. 3, line 17 – col. 4, line 30 and col. 8, line 11 – col. 9, line 21);

providing a database at the intermediate location having stored therein an associative database associating a plurality of unique codes with routing information on the network, and also for storing user profile information associated with user IDs received thereby (Hudetz, abstract and col. 3, line 17 – col. 4, line 30 and col. 8, line 11 – col. 9, line 21);

comparing the received unique code with the information stored in the database and, if a corresponding unique code is stored therein, forwarding both the user profile information and the associated routing information back to the user's computer (Hudetz, abstract and col. 3, line 17 – col. 4, line 30 and col. 8, line 11 – col. 9, line 21); and

at the user's computer, utilizing the routing information to interconnect with the advertiser's location on the network and forwarding to the advertiser's location the user profile

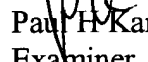
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information (Hudetz, abstract and col. 3, line 17 – col. 4, line 30 and col. 8, line 11 – col. 9, line 21).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul H Kang whose telephone number is (703) 308-6123. The examiner can normally be reached on 9 hour flex. First Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Rinehart can be reached on (703) 305-4815. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-9731 for regular communications and (703) 305-3900 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.


Paul H Kang
Examiner
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February 25, 2002

MEHMET B. GECKIL
PRIMARY EXAMINER

